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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,216	10/03/2003	Takayuki Uchida	031732	8587

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EXAMINER
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VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/677,216

Applicant(s)

UCHIDA, TAKAYUKI

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to the applicant's amendment filed on 7/13/2003.
2. Claims 1-24 have been canceled and claims 25-34 added as new claims.
3. Claims 25-34 are pending and presented for examination.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 25-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "upper retrieval item information" and the "retrieval mode information" limitations recited in claims 25, 26, 27, 31 and 32 do not describe in the specification in a way to enable one having ordinary skill to make and use the invention. Applicant(s) does/do not provide a definition as to what "upper retrieval item information" and "retrieval mode information" meant in the specification. The new matter that has been entered into the claims affects the scope of the claims. Therefore, the rejection of claims 25-34 is proper because the new matter such as "upper retrieval item information" and "retrieval mode information" is not described in the application as originally filed. (See MPEP 608.04).

More specifically, the specification as originally filed has no support for the adding limitations above. Applicant(s) is/are advised to amend the specification or cancel the above-mentioned limitations from the claims and furthermore, applicant(s) is/are reminded that no new matter should be added.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 25-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 25, 31 and 32 recited the limitations "the plurality of retrieval item information being defined with upper retrieval item information and/or lower retrieval item information to be hierarchically arranged". The use of the term "and/or" render the claims indefinite, because it is unclear what applicant's intended metes and bounds of the claims are, since the claims are never defined.

As per claims 26-30, and 33-34, they are at least rejected for their dependencies, directly or indirectly on the rejected claims 25 and 32.

b) There is insufficient antecedent basis for the limitation of "the immediately lower retrieval item information" recites in claim 25 line 12 and claim 31 line 14. Appropriate correction or deletion is required.

c) As per claims 33 and 34, it is unclear what applicant's intended metes and bounds of

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the claims are, because incorporation by reference to another claim invokes the entire claim, which is being incorporated. Accordingly, there cannot be any inconsistency between the preamble of the claim incorporated by reference and the claim containing the incorporation.

When such inconsistency exists, the claim is indefinite under 35 USC 112, second paragraph. See MPEP 2173.02. Therefore, Applicant(s) is/are advised to amend the claims by rewriting them in complete independent form containing all the limitations of the claim incorporated in order to solve the 112 rejection set forth in the claims.

A rejection under the art for these mentioned claims is not appropriate at this time. (See MPEP 2163.01).

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 25-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 25-30 appear to be directed to an abstract idea rather than a practical application of the idea. The claims do not result in a physical transformation, nor do they appear to provide a useful, concrete and tangible result. The claimed steps of “selecting...”, “acquiring...” and “displaying...” do not produce a concrete, useful and tangible result. What is being displayed is intended to be used for “displaying...” that not produce any output yet. The display is not claimed as applied in a practical application which provides a tangible, i.e., real world result.

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Instead, it appears to remain a mere abstraction. Therefore, the claims are not statutory and rejected under 35 U. S. C. 101.

10. Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically directed towards a program, per se. Claim 33 as written and taken as a whole is directed to a mere program listing, i.e., to only its description or expression, which can be written on a piece of paper. The claim as written is not embodied on a computer-readable medium needed to realize the program's functionality. A program being recorded in a recording medium in a computer readable manner is not a computer readable storage medium. Therefore, the claim is rejected under 35 U.S.C. 101 as being drawn to non-statutory subject matter.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Points Of Contact***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*J.V.*

Jacques Veillard  
Patent Examiner TC 2100

September 12, 2006

*Jeffrey Gaffin*  
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